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REMARKS/ARGUMENTS

Claims 35-68 are pending in the application and have been considered by the Examiner. In that Office action, claims 46-62 and 68 stand rejected under 35 U.S.C. 101 as being drawn to non-statutory subject matter. Claims 35-40, 46-58, and 64-68 stand rejected under 35 U.S.C. 102(e) as anticipated by Su (20030084124). Claims 41 stand rejected under 35 U.S.C. 103(a) as unpatentable over Su (20030084124). Claims 42-45 and 62 stand rejected under 35 U.S.C. 103(a) as unpatentable over Su (20030084124) in view of RSS20 Spec. Claims 61 and 63 stand rejected under 35 U.S.C. 103(a) as unpatentable over Su (20030084124 in view of Bolle 6,892,193

The Rejection under 35 U.S.C. 101:

At pages 3-4 of the Office action of October 26, 2007, the Examiner has set forth the basis and reasoning for the rejection of Claims 46-62 and 68 under 35 U.S.C. 101 as being directed to non-statutory subject matter and claims "Software" per se. The Examiner points out that "Software is functional descriptive material that can be considered statutory only if it is both functional and clearly embodied on a computer readable medium and designed to support specific data manipulation function.

In an effort to address this rejection, applicant has modified claim 46, on which the remaining claims rejected on this basis are either directly or indirectly dependent. Claim 46 is now directed to "A computer program embodied on a computer readable medium for use with a computer". Thus, as suggested by the Examiner, the present claim is directed to a program on a computer readable medium and designed to support specific data manipulation function as described. Since the remaining claims depend either directly or indirectly from claim 46 they, also, include the limitation the the program is embodied on a computer readable medium for use with a computer.

Applicant believes that as presently modified, claims 46-62 and 68 are now directed to statutory subject matter as explained at page 53 of the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility which provides

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In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory.

Thus, applicant would request reconsideration and withdrawal of the rejection of claims 46-62 and 68 under 35 U.S.C. 101.

The Rejection under 35 U.S.C. 102(e):

At pages 4-13 of the most recent Office action the Examiner explains the basis and reasoning in support of the rejection of claims 35-40, 46-58 and 64-68 under 35 U.S.C. 102(e) as anticipated by Su (20030084124). The Examiner urges that, as to claim 35, the independent method claim, that Su discloses the claimed aspect of loading preselected information data for display on a computer monitor by running a stand alone computer application program independently of the other programs on a computer, the application program being configured to detect the occurrence of a wait event caused by at least one program being run on the computer, the wait event resulting in a user having to wait for the computer to complete processing tasks commanded from one or more other programs being run on the computer, wherein a system and method for information delivery to a client station has a screen saver application maintained thereon and a server is operative to transfer information maintained therein in response to a query. The server transfers the information maintained thereon to the client station via communication medium in response to a request from the screen saver application and the transferred information is presented on the client station offline.

Applicant would initially note that claim 35, as amended herewith, is directed, in pertinent part, to a method of loading preselected information data for display on a computer monitor by running a stand alone computer application program independently of other programs on a computer, the application program being configured to detect the occurrence of a wait event or wait condition caused by at least one other program being run on the computer, the wait event resulting in a user having to wait for the computer to complete processing tasks commanded from one or more other

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programs being run on the computer, the method comprising the detection of such a wait event or condition and the loading of a preselected information datafile.

Applicant would urge that the Su reference fails to disclose or describe these specific claim limitations. A reasonable reading of claim 35 makes clear that the present invention as claimed is clearly directed to a computer application program configured to detect the occurrence of a "wait event" or "wait condition" as specifically defined by the claim. A wait event or condition occurs when a computer is **occupied** with processing tasks. The "wait event" being defined as a computer user having to wait for the computer to complete processing tasks commanded from one or more other programs being run on the computer. The present invention thus detects wait events occurring in other programs on the computer, and more particularly detects these wait conditions independently of the other programs. Furthermore, the main difference between Su et al. and the present invention is that Su et al. does not function by way of a wait event, and there is no disclosure regarding this form of trigger, but rather it appears to be triggered by extended periods of **inactivity or idletime** – the opposite of the present invention! Applicant would note claim 3 of the Su reference which specifically calls for "an inactive mode". Also, in paragraph 0003 of page 1 Su states that the program described therein is "only active during extended periods of inactivity" as when the "computer is not performing any function or the user is not using the computer." The program of Su is stated to be a screen saver which is activated during downtime when a computer is NOT performing any function. This is the exact opposite of the presently claimed invention. Essentially it would seem that Su et al. is teaching away from the present invention.

The Examiner would appear to acknowledge this reading of the Su reference since he notes that "Su discloses that the information on display 30 is presented during down time periods or idle, referencing Su at page 3, paragraph 0027, lines 19-22." in the Office action at the bottom of page 5 of the Office action.

Further, applicant would urge that Su, also, fails to disclose or describe the claim limitation of claim 35 which specifically provides that the information to be displayed is "preselected" as required by claim 35.

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To the extent that the Examiner has similarly rejected the other independent claim 46, Applicant would note that this claim also includes the limitations discussed with regard to claim 35. Thus, Su also fails to disclose every limitation of that claim.

As to claims 36-40 and 45-58 and 64-68, applicant would note that these claims depend directly or indirectly from either claims 35 and claim 46. Thus, they each include those limitations discussed above as being present in claims 35 and 46. Therefore, the reference also fails to describe or disclose every limitation required by each of these claims.

Applicant would urge that the program described by Su is materially different from that of the present invention, is intended to function differently and provide different information.

Applicant believes that the standard for a rejection based on anticipation requires the disclosure, in a single prior art reference, of each element of the claim under consideration. W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Here, presently amended claims 35 and 46, as well as the claims which depend directly or indirectly therefrom include specific limitations which the reference relied upon by the Examiner fails to disclose or even suggest. These limitations are discussed above.

Therefore applicant would argue that Su fails to anticipate the present claims since it fails to disclose each and every limitation of the pending claims, and particularly the two independent claims. Therefore applicant requests reconsideration of this basis of rejection and the withdrawal of the rejection of claims 35-40, 46-58 and 64-68 under 35 U.S.C. 102(e) as being anticipated by Su (20030084124).

The Rejections under 35 U.S.C. 103(a):

The Rejection of claim 41:

At page 13-14 of the Office action of October 26, 2007, the Examiner has set

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forth the reasoning and basis for the rejection of claim 41 as being unpatentable over Su (20030084124) taken in view of Longinotti (20020049634).

The Examiner urges that Su discloses the limitations of claim 41 as discussed with regard to claim 35 on which it depends. However the Examiner acknowledges (page 13 of the Office action) that Su fails to "teach the claimed aspect of selecting an information datafile for use as a teaching too, the teaching tool means allowing a used to select preferences such as the subject matter, a set of questions and degree of difficulty with the subject matter and the sequence of display of each said question and associated answer." However, the Examiner urges that Longinotti discloses just such a datafile for teaching purposes. The Examiner concludes "It would be obvious to one of ordinary skill in the art at the time of the invention to combine Su's data file display system with Longinotti's interactive quiz system, because it would allow users to perform education quiz.

Applicant would initially renew the argument set forth above that Su does not disclose the presently claimed invention of claim 35 on which 41 depends. As such, it would not have been obvious to modify that which Su discloses in a manner which would have resulted in the presently claimed invention. In addition, what is missing from this analysis is anything to be found in the prior art which would have suggested such a combination of teachings. Su does not describe or even suggests the use of a teaching data file of any type, not alone a data file of the type taught by Longinotti. Similarly, Longinotti does not suggest or describe the use of the disclosed data file system with anything that would resemble the system of Su.

It is well settled that a conclusion of obviousness premised on a combination of references must identify a reason, suggestion, or motivation which would have led an inventor to combine those references. Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629, (Fed. Cir. 1996). It is insufficient that the prior art discloses the components of the claimed invention, either separately or in other combinations; there must be some teaching, suggestion, or incentive to make the

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combination made by applicant. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) (insufficient to select from the prior art the separate components of the inventor's combination, using the blueprint supplied by the inventor). Here, there is nothing which would have led one of ordinary skill in this art to make use of the data files of Longinotti in the application of Su.

In fact, the only suggestion or teaching which would direct one of ordinary skill in this art to a method as presently claimed is found in applicant's disclosure of the invention in the Specification and claims. However, use of that information would constitute impermissible hindsight in the construction of the rejection under 35 USC 103(a). In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

Applicant would argue that identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, as set forth in In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) "To establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the [applicant]. Here, there is no such motivation, suggestion or teaching which would have reasonably led those skilled in this art to use the data file of Longinotti in the system disclosed by Su. Further, even if such a substitution or combination was reasonable, one skilled in the art would still not have the data application as presently claimed.

Thus, applicant would urge that the evidence provided by the Examiner is not sufficient to reasonably support the conclusion of obviousness reached. Therefore, applicant would request reconsideration and withdrawal of this ground of rejection under 35 U.S.C. 103(a).

The Rejection of claims 42-45 and 62:

At pages 14-17 of the Office action of October 26, 2007, the Examiner sets forth the basis and reasoning in support of the rejection of claims 42-45 and 62 under 35 U.S.C. 103(a) as unpatentable over Su (20030084124) taken in view of RSS 2.0

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Specification at Harvard Law, July 15, 2003.

The Examiner urges that Su discloses the limitations of claim 42, and thus claims 43-45 and 62, as discussed with regard to claim 35 on which it depends. However the Examiner acknowledges (page 16 of the Office action) that Su fails to "teach the the claimed aspect that the information data is fed RSS. However, the Examiner urges that RSS 2.0 at Harvard Law, July 15, 2003 discloses RSS web context syndication format. The Examiner concludes that "It would be obvious to one of ordinary skill in the art at the time of the invention to combine Su's display system with RSS 2.0 because it allows one web site to share information with another web site.

Applicant would initially note that the claimed invention does not relate to the sharing of data between two web sites as described. Further, at best, it can be said that the RSS 2.0 at Harvard Law, July 15, 2003 would inform one skilled in this art that the format exists. It does not suggest the use of the format in a particular system, such as that of Su or, for that matter, the present invention. Similarly, Su does not suggest or direct one to this particular format.

Applicant would, also, renew the argument set forth above that Su does not disclose the presently claimed invention of claim 35 on which 42 depends. As such, it would not have been obvious to modify that which Su discloses in a manner which would have resulted in the presently claimed invention. In addition, what is missing from this analysis is anything to be found in the prior art which would have suggested such a combination of the two teachings.

As noted above, it is insufficient that the prior art discloses the components of the claimed invention, either separately or in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by applicant.

Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) (insufficient to select from the prior art the separate components of the inventor's combination, using the blueprint supplied by the inventor). Here, there is nothing which

would have led one of ordinary skill in this art to make use a particular format, such as the RSS format, merely because it was out there.

Thus, the present rejection is flawed for the same reason as the rejection of claim 41 under 35 U.S.C. 103(a). Therefore, applicant would request reconsideration of this ground of rejection and the withdrawal of the rejection of claims 42-45 and 62 under 35 U.S.C. 103(a) as unpatentable over Su when taken in view of the RSS document.

The Rejection of claims 61 and 63:

At pages 18-19 of the Office action of October 26, 2007, the Examiner sets forth the basis and reasoning in support of the rejection of claims 61 and 63 under 35 U.S.C. 103(a) as unpatentable over Su (20030084124) taken in view of Bolle (6,892,193).

The Examiner urges that Su discloses the limitations of claim 61 and 63, as discussed with regard to claims 35 and 46 on which they depend. However the Examiner acknowledges (page 19 of the Office action) that Su fails to "teach the aspect of generating a personal note annotation, categorizing by color and manually select the files." However, the Examiner notes that Bolle in 6,892,193 discloses the claimed aspect of file category is assigned a different colour to distinguish one category of said personal note from another category, wherein media items are categorized (or classified) based both on textual features and visual features, including color properties and motion properties of key intervals.

Thus, the Examiner concludes that "It would be obvious to one of ordinary skill in the art at the time of the invention to combine Su's display system with Bolle's file management concept of annotation, categorization by color, and manually select the files, because this would allow users more efficient file management practices.

Applicant would initially note that Bolle does not relate to or mention color coded note pads as required by claim 61. Further, Bolle is making use of "visual features including, but not limited to color properties of key intervals." (See Abstract). It is not readily apparent how this coloring system relates to either the system of Su or that of the present invention. Again, as with the other rejections under 35 U.S.C. 103(a), there is

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also no suggestion, reason or motivation to be found in the prior art itself that would suggest the use of the categories system of Bolle in the system of Su.

To the extent that it can be argued that Bolle demonstrates that a color system is useful in categorizing data segments, it remains that there is nothing which would have led one skilled in the art to combine this particular teaching with that of Su. Even if so combined, it is not readily apparent that you would arrive at the presently claimed system.

As previously pointed out, merely because the components of a claimed invention can, individually, be found in the prior art, this is not sufficient, standing alone, to reasonably support a conclusion of obviousness within the meaning of 35 U.S.C. 103.

Thus, the present rejection is flawed for the same reason as the rejections of other claims under 35 U.S.C. 103(a). Therefore, applicant would request reconsideration of this ground of rejection and the withdrawal of the rejection of claims 61 and 63 under 35 U.S.C. 103(a) as unpatentable over Su when taken in view of the Bolle.

Conclusion:

Applicant has addressed each ground of rejection, individually. However, the core factor remains that Su simply does not disclose the type of system presently claimed in claims 35 and 46, on which all other claims depend either directly or indirectly. For this reason, no matter how Su could be modified, in view of the teaching of the other references noted by the Examiner, it remains that one skilled in this art would not have arrived at the claimed invention. Thus, Applicant, respectfully, requests reconsideration of all grounds of rejection of record, withdrawal of all grounds of rejection and a determination that all claims are allowable.

Should any official at the United States Patent and Trademark Office deem that any further action by the Applicant or Applicant's undersigned representative is desirable and/or necessary, the official is invited to telephone the undersigned at the number set forth below.

The Commissioner is hereby authorized to charge any fees which may be required regarding this application under 37 CFR §§ 1.16-1.17 or credit any overpayment, to

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deposit account No. 503321. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, or otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 503321.

Respectfully submitted,

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